



MS APPEAL BRIEF - PATENTS  
PATENT  
1163-0214P

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3-30-03  
P.2

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of Before the Board of Appeals

Toshiaki SHIMADA, et al.

Appeal No.:

Appl. No.: 09/210,775

Group: 2613

Filed: December 14, 1998

Examiner: Allen C. Wong

Conf.: 4920

For: MOVING PICTURE ENCODING SYSTEM

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Technology Center 2600

**MS APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

March 26, 2004

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on January 29, 2004.


☐ An extension of time under 37 C.F.R. § 1.136(b) to was requested on and was approved on .

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
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Applicant: Toshiaki SHIMADA, et al. Conf.: 4920  
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Alexandria, VA 22313-1450

March 26, 2004

Sir:

In reply to the Examiner's Answer dated January 29, 2004, Appellants provide the following comments.

In the Section marked Response to Arguments in the Examiner's Answer, the Examiner addresses only a few of the arguments presented in Appellants Appeal Brief. First, the Examiner argues against Appellants arguments on pages 13 and 14 of the Appeal Brief. Appellants note that the arguments on pages 13 and 14 of the Appeal Brief refer to arguments in support of previous discussions of the Lee reference within the Appeal Brief. These discussions verify that Lee teaches the use of a scene change threshold, but does not detect motion between the frames as a whole, thus supporting the previous arguments in the Appeal Brief illustrating the difference between the Lee reference and the claimed invention. The Examiner has taken this argument out of context in the

Examiner's answer and has not considered the totality of arguments presented in the Appeal Brief which focus on the differences between Lee and the presently claimed invention.

Second, Appellants respectfully disagree with the Examiner's assertion that motivation is provided to combine Odaka and Lee's teachings. The Examiner sole argument for providing motivation rests on the fact that both Odaka and Lee's apparatus "are used in the same MPEG video encoding environment".

Appellants note that when an obviousness determination relies on the combination of two or more references, there must some suggestion or motivation to combine the references. The suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art or from the nature of the problem to be solved. When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest desirability, and thus the obviousness of making the combination. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1355 (Fed. Cir. 1999).

Further, even if the references could be combined, which appellants maintain they cannot, the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 690. 16 USPQ2d 1430 (Fed. Cir. 1990).

Throughout prosecution the Examiner has failed to indicate any suggestion or teaching within the references themselves that would lead one of ordinary skill to seek modification of the teachings within the Odaka reference to include a teaching of Lee. In fact, no suggestion can be found within the reference themselves and thus the Examiner's only basis for motivation is to rely on the fact that Odaka and Lee provide teachings within the same MPEG encoding environment. It is apparent, however, that the mere fact that two references provide teachings within the same technical environment does not manifest motivation to combine the teachings these two references. As MPEG technology is a standard used universally, it would not be surprising if hundreds or thousands of references refer to the MPEG video encoding environment. Are we to assume that each reference implicitly provides motivation to combine the teachings of the reference with another reference only because they provide teachings within the same technical MPEG encoding environment? That would be absurd and contrary to the caselaw expounded by the courts in this area. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998).

Appellants maintain that along with Odaka and Lee not teaching each and every feature of appellant's claims, there is no motivation to combine Odaka's and Lee's teachings.

Finally, Appellants argue on page 16 of the Appeal Brief that Odaka and Lee rely upon different frame types with Lee specifically relying on six (6) custom

frame definitions. Appellants argue that this variation destroys the combinability of Odaka and Lee.

The Examiner asserts on page 9 of the Examiner's Answer that Odaka's frame types provided in Table 1 at column 15 provides "the same custom frame definitions as Lee" with Table 2 at column 16 providing a "more custom set of frame definitions". It is easily seen that Table 1 provides the basic I, P, B frame definitions while Table 2 of Odaka provides a specific customization of the frame definitions. In fact, Table 2 provides 8 different frame definitions that are used in an embodiment of Odaka's system. These frame definitions are I, P0, P1, P2, B0, B1, B2 and B3. Thus, Odaka either uses three (3) frame definitions or eight (8) specific frame definitions. None of these definitions match Lee's six (6) specific definitions. Thus, appellants maintain these argument that this difference provides further evidence destroying the Examiner's allegation that Odaka and Lee's teachings can be combined.

### Conclusion

Appellants respectfully submit that the above arguments in combination with those presented in the Appeal Brief illustrate the failure of Odaka and Lee to satisfy the requirements under 35 U.S.C. for rejecting Appellants claims. Accordingly, Appellants maintain that the rejection under 35 U.S.C. §103 should be reversed. Accordingly, reversal of the rejection is respectfully requested.

Appl. No. 09/210,775

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings (Reg. No. 48,917) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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